

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-22 are currently pending. Claims 1, 8, 13, and 18 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 1-22 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,848,413 to Wolff (hereinafter "the '413 patent").

Applicants wish to thank the Examiner for the interview granted Applicants' representative on July 12, 2005, at which time a proposed amendment to the claims was discussed. At the conclusion of the interview, the Examiner agreed that the proposed amendment would likely overcome the outstanding rejection of the claims. However, no agreement on the patentability of the claims was reached pending the Examiner's further consideration of the claims upon formal submission of a response to the outstanding Office Action.

Amended Claim 8 is directed to a method for faxing files received from a remote client, comprising: (1) sending a fax document form to a remove client over a network; (2) receiving fax information entered on the fax document form from the remote client, the fax information including an identifier identifying a destination fax machine, and a file to be faxed to the destination fax machine; (3) connecting the network fax machine to the destination fax machine using the identifier; and (4) sending the file to the destination fax machine by a facsimile communication. Claim 8 has been amended to clarify that the destination fax machine is located remotely from the remote client. No new matter has been added.

The '413 patent is directed to a method and apparatus for accessing and publishing electronic documents. As shown in Figure 2, the '413 patent discloses a system in which a fax machine 101 is able to receive documents from a gateway 102 in the following manner. First, the fax machine 101 receives a document from gateway 102 that contains links to other documents that may be retrieved for the user, for example, hypertext links that are encoded in a machine readable form, such as in bar codes. Further, the '413 patent discloses that the user may mark the form by, for example, circling a hyperlink that it would like to receive information about, and sending the form back to the gateway 102. See step 204 of Figure 2. Next, the gateway sends the desired documents by fax to the fax machine.¹ However, Applicants respectfully submit that the '413 patent fails to disclose the step of receiving fax information entered on the fax document form from a remote client, the fax information including an identifier identifying a destination fax machine, and a file to be faxed to the destination fax machine, as recited in Claim 8. Rather, the '413 patent merely discloses that a fax machine 101 can send information to a gateway 102, including, in one embodiment, information to be published on a website. However, the '413 patent does not disclose that, in sending the information to be published on the website, the fax machine 101 sends an identifier identifying a destination fax machine. Further, the '413 patent does not disclose that the fax machine 101 sends a file to be faxed to a destination fax machine, wherein the destination fax machine is located remotely from the remote client. Accordingly, for the reasons stated above, Applicants respectfully submit that the rejection of Claim 8 (and dependent Claims 9-12) is rendered moot by the present amendment to Claim 8.

Claims 1, 13, and 18 recite limitations analogous to the limitations recited in Claim 8. Moreover, Claims 1, 13, and 18 have been amended in a manner analogous to the amendment to Claim 8. Accordingly, for the reasons stated above for the patentability of Claim 8,

¹ See '413 patent, col. 5, lines 35-60.

Applicants respectfully submit that the rejections of Claims 1, 13, and 18 (and all associated dependent claims) are rendered moot by the present amendment to those claims.

Thus, it is respectfully submitted that independent Claims 1, 8, 13, and 18 (and all associated dependent claims) patentably define over the '413 patent.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Attorney of Record
Registration No. 34,648
Kurt M. Berger, Ph.D.
Registration No. 51,461

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

JJK/KMB/law/fbl
I:\ATTY\KMB\5244\5244-0107\52440107-AF 12 JULY 05